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10/538,270	06/10/2005	Noriko Yamashita	271659US2X PCT	3233
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MITTAL, KRISHAN K	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/538,270	Applicant(s) YAMASHITA ET AL.	
	Examiner Kris Mittal	Art Unit 4115	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/10/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is in response to Patent Application and Preliminary Amendment filed on June 10, 2005. This is a non-final first office action on the merits. Claims 1-15 are pending.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed with the instant application.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on June 10, 2005 is in compliance with the provisions of 37 CFR 1.97 and, therefore, was considered by the Examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 14, the claimed invention does not fall within the patentable eligible subject matter recited in 35 U. S. C. 101 (process, machine, manufacture or

Art Unit: 4115

composition of matter). The claimed invention is a computer program. Computer programs per se are deemed to lack a useful, concrete and tangible result and, therefore, are deemed to be directed towards non statutory subject matter.

Appropriate action is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagano et al., U.S. Publication No. 2002/0062250 (hereinafter referred to as Nagano).

As to claim 1, Nagano discloses a content information processing apparatus characterized by comprising: first storage means for storing information of each content (0051: the advertisement *content* 108 is stored in the advertisement server 354) to be provided to a user at a real place (0051: For the user to whom the advertisement is distributed, the advertising administration division 356 stores the advertisement in the advertisement server 354) and information of each content supplier, who provides the content, such that the information is

associated with the other information (0061: The commercial sponsor 110 sends the advertisement data to the advertisement administration firm 112, who registers this advertisement in the advertisement server); viewing information processing means for specifying information of a content distributed to a terminal of the user (0051: the advertising administration firm 112 determines the user to whom the advertisement is distributed: 0045: the receiver terminal 150 owned by the end user 120 receives the advertisement information) via a network (0051: communications by Internet is used as the transmission line A402 for this advertisement distribution), viewing history storage means for storing viewing historical information including at least the specified information of the content distributed to the user (0046: when an advertisement has been played, the commercial sponsor, content, classification and time of play of the played advertisement are recorded and stored on a hard disk) ; and incentive means for extracting the information of the content viewed by the user from the viewing historical information (0074: The transmission data selection division 322 extracts the information recorded in the statistic user data file 314, statistic overall data file 318 and statistic history data file 310), specifying the content supplier associated with the extracted content with reference to the first storage means (0074: for each commercial sponsor), and giving a predetermined incentive to the specified content supplier in accordance with the description of the content distributed to the user and the number of contents (0075: the transmitter 324 adds information extracted by the transmission data selection division 322 to the

information on the charge calculated by advertisement expense computation division 320, and send it to the commercial sponsor).

As to claim 2, Nagano discloses the content information processing apparatus according to Claim 1, further comprising distribution means for distributing a content to the terminal of each user (0051: The program stored in the program server 364 is sent from the program provider 111 to the receiver terminal 150 by the transmission line C 404, the same transmission line as the transmission line A 402 or different from it).

As to claim 3, Nagano discloses the content information processing apparatus according to Claim 1, wherein the apparatus is connectable via a communication network (0051: communications by satellite or internet) to a content distribution terminal (0051: this program is stored in the in the storage unit such as a hardware in the receiver terminal 150) for distributing a content to each user over a network (0051: the Internet is used as the transmission line A402 for this advertisement distribution), and the viewing information processing means obtains viewing historical information of a content distributed from the terminal of the content distributor to the user (0066: History information, personal information and advertisement information received by the above-mentioned receiver are stored in the recording circuit such as a hard disk as a personal history data file

306, individual user data file 304 and advertisement information data file 330 respectively, from time to time).

As to claim 4, Nagano discloses the content information processing apparatus according to claim 1, further comprising: second storage means for storing at least identification information of each user and assigned-area information indicating an area which the user belongs to (0041: In this case, the personal information provided is determined based on the agreement with the end user 120), wherein the first storage means further stores assigned-area information indicating an area which each content supplier belongs to (0037: commercial sponsor provides information to the advertisement administration firm), and the incentive means specifies area information of a user, to which the content is distributed, with reference to the second storage means, specifies the content supplier belonging to the specified area with reference to the first storage means, and gives an incentive to the specified content supplier for the content distributed to the user (0037: in this case an agreement may be signed between the advertisement administration firm and commercial sponsor regarding the terms of the agreement including charge calculation and the like).

As to claim 5, Nagano discloses the content information processing apparatus according to claim 4, further comprising: registration means for accepting registration of assigned-area information indicating an area, to which a viewer belongs, to store the information in the second storage means (0039: the end

user provides personal information *including* address)

As to claim 6, Nagano discloses the content information processing apparatus according to claim 1, wherein the viewing information processing means provides viewing historical information to each content supplier (0050: The viewing history of the end user 120 and information on the end user are collected and are sent to the commercial sponsor).

As to claim 7, Nagano discloses the content information processing apparatus according to claim 1, wherein with reference to the first storage means, the viewing information processing means provides each user with the information pieces of the content suppliers registered in association with the content viewed by the user (0043: the advertisement information is sent to the end user 120) and accepts the information of a desired content supplier selected from among the content suppliers by the user (0038: the type of the advertisement to be viewed can be set by the end user as desired), and the incentive means gives an incentive to the content supplier accepted from the user (0048: the advertisement administration firm edits the history into statistic information on the number of viewers, viewing rating and average viewing time and a bill is sent to the sponsor accordingly).

As to claim 8, Nagano discloses the content information processing apparatus

according to Claim 7, wherein the first storage means further stores advertising information of each content supplier (0045: refers to advertisement data storage file), and when providing each user with the information pieces of the content suppliers the viewing information processing means provides the user with the advertising information pieces of the content suppliers stored in the first storage means (0045: the end user can select a desired one from the recorded advertisements),

As to claim 9, Nagano discloses the content information processing apparatus according to claim 1, further comprising: user information storage means for relating each user to a content supplier to store the relationship therebetween (0051: user information and advertisement viewing information are input into interest storage 444), wherein the incentive means gives an incentive for the content viewed by the user to the related content supplier with reference to the user information storage means (0051: the advertisement suited to the users' taste is selected by the interest comparator 442 from the multiple advertisements stored in the advertising data file).

As to claim 10, Nagano discloses the content information processing apparatus according to claim 1, wherein the incentive means collects a charge from each user who has received the distribution of the content and gives an allocation, calculated from the collected charge at a predetermined rate, as an incentive to

the content supplier (0035: a rental contract on receiver terminal 150 is signed between the advertisement administration firm 112 and end user 120. 0035: If the watch rating has exceeded a certain level, discount is applied to the rental charge, as a merit charge).

As to claim 12, Nagano discloses a content information processing system including a distribution apparatus for distributing a content to a terminal of the user via a network (0045: the receiver terminal 150 owned by the end user 120 receives the advertisement information; 0051: communications by Internet is used as the transmission line A402 for this advertisement distribution), and a server for processing information related to each content distributed by the distribution apparatus, characterized in that the server comprises: viewing information processing means for specifying information of a content distributed from the distribution apparatus to the terminal of the user (0051: the advertising administration firm 112 determines the user to whom the advertisement is distributed: 0045: the receiver terminal 150 owned by the end user 120 receives the advertisement information); first storage means for storing information of each content (0051: the advertisement *content* 108 is stored in the advertisement server 354) to be provided to a user at a real place (0051: For the user to whom the advertisement is distributed, the advertising administration division 356 stores the advertisement in the advertisement server 354) and information of each content supplier, who provides the content, such that the information is

associated with the other information (0061: The commercial sponsor 110 sends the advertisement data to the advertisement administration firm 112, who registers this advertisement in the advertisement server); viewing history storage means for storing viewing historical information including at least the specified information of the content distributed to the user (0046: when an advertisement has been played, the commercial sponsor, content, classification and time of play of the played advertisement are recorded and stored on a hard disk); and incentive means for extracting the information of the content viewed by the user from the viewing historical information (0074: The transmission data selection division 322 extracts the information recorded in the statistic user data file 314, statistic overall data file 318 and statistic history data file 310), specifying the content supplier associated with the extracted content with reference to the first storage means ((0074: for each commercial sponsor), and giving a predetermined incentive to the specified content supplier in accordance with the description of the content distributed to the user and the number of contents (0075: the transmitter 324 adds information extracted by the transmission data selection division 322 to the information on the charge calculated by advertisement expense computation division 320, and send it to the commercial sponsor)..

As to claim 13, Nagano discloses a content information processing method executed by a computer, characterized in that the computer performs the steps

of: storing information of each content (0051: the advertisement *content* 108 is stored in the advertisement server 354) to be provided to a user at a real place (0051: For the user to whom the advertisement is distributed, the advertising administration division 356 stores the advertisement in the advertisement server 354) and information of each content supplier, who provides the content, such that the information is associated with the other information (0061: The commercial sponsor 110 sends the advertisement data to the advertisement administration firm 112, who registers this advertisement in the advertisement server); specifying information of a content distributed to a terminal of the user via a network (0051: the advertising administration firm 112 determines the user to whom the advertisement is distributed: 0045: the receiver terminal 150 owned by the end user 120 receives the advertisement information; 0051: communications by Internet is used as the transmission line A402 for this advertisement distribution), storing viewing historical information including at least the specified information of the content distributed to the user (0046: when an advertisement has been played, the commercial sponsor, content, classification and time of play of the played advertisement are recorded and stored on a hard disk); and extracting the information of the content viewed by the user from the viewing historical information (0074: The transmission data selection division 322 extracts the information recorded in the statistic user data file 314, statistic overall data file 318 and statistic history data file 310), specifying the content supplier associated with the extracted content with

reference to the first storage means (0074: for each commercial sponsor), and giving a predetermined incentive to the specified content supplier in accordance with the description of the content distributed to the user and the number of contents (0075: the transmitter 324 adds information extracted by the transmission data selection division 322 to the information on the charge calculated by advertisement expense computation division 320, and send it to the commercial sponsor).

As to claim 14, Nagano discloses a computer program (0051: The program stored in the program server 364) allowing a computer to perform the steps of: storing information of each content (0051: the advertisement *content* 108 is stored in the advertisement server 354) to be provided to a user at a real place (0051: For the user to whom the advertisement is distributed, the advertising administration division 356 stores the advertisement in the advertisement server 354) and information of each content supplier, who provides the content, such that the information is associated with the other information (0061: The commercial sponsor 110 sends the advertisement data to the advertisement administration firm 112, who registers this advertisement in the advertisement server); specifying information of a content distributed to a terminal of the user via a network (0051: the advertising administration firm 112 determines the user to whom the advertisement is distributed: 0045: the receiver terminal 150 owned by the end user 120 receives the advertisement information; 0051:

communications by Internet is used as the transmission line A402 for this advertisement distribution); storing viewing historical information including at least the specified information of the content distributed to the user (0046: when an advertisement has been played, the commercial sponsor, content, classification and time of play of the played advertisement are recorded and stored on a hard disk); and extracting the information of the content viewed by the user from the viewing historical information (0074: The transmission data selection division 322 extracts the information recorded in the statistic user data file 314, statistic overall data file 318 and statistic history data file 310), specifying the content supplier associated with the extracted content with reference to the first storage means (0074: for each commercial sponsor), and giving a predetermined incentive to the specified content supplier in accordance with the description of the content distributed to the user and the number of contents (0075: the transmitter 324 adds information extracted by the transmission data selection division 322 to the information on the charge calculated by advertisement expense computation division 320, and send it to the commercial sponsor).

As to claim 15, Nagano discloses a computer-readable recording medium storing a computer program (0081: The program read-out 420 plays the programs stored in the program data file 408) which allows a computer to perform the steps of:

storing information of each content (0051: the advertisement content 108 is stored in the advertisement server 354) to be provided to a user at a real place (0051: For the user to whom the advertisement is distributed, the advertising administration division 356 stores the advertisement in the advertisement server 354) and information of each content supplier, who provides the content, such that the information is associated with the other information (0061: The commercial sponsor 110 sends the advertisement data to the advertisement administration firm 112, who registers this advertisement in the advertisement server); specifying information of a content distributed to a terminal of the user via a network (0051: the advertising administration firm 112 determines the user to whom the advertisement is distributed: 0045: the receiver terminal 150 owned by the end user 120 receives the advertisement information; 0051: communications by Internet is used as the transmission line A402 for this advertisement distribution); storing viewing historical information including at least the specified information of the content distributed to the user (0046: when an advertisement has been played, the commercial sponsor, content, classification and time of play of the played advertisement are recorded and stored on a hard disk); and extracting the information of the content viewed by the user from the viewing historical information (0074: The transmission data selection division 322 extracts the information recorded in the statistic user data file 314, statistic overall data file 318 and statistic history data file 310), specifying the content supplier associated with the extracted content with

reference to the first storage means (0074: for each commercial sponsor), and giving a predetermined incentive to the specified content supplier in accordance with the description of the content distributed to the user and the number of contents (0075: the transmitter 324 adds information extracted by the transmission data selection division 322 to the information on the charge calculated by advertisement expense computation division 320, and send it to the commercial sponsor).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagano in view of Ji, U.S. Publication No. 2004/0221018.

As to claim 11, Nagano does not explicitly disclose content apparatus, wherein content includes a video content to be screened at a theater, and the content supplier includes a theater and/or a video content distributor. However, Ji teaches an apparatus wherein content includes a video content to be screened at

Art Unit: 4115

a theater, and the content supplier includes a theater or video content distributor (0175: movies manufactured by film makers may also be converted to contents data and transmitted on the Internet broadcasting stations, and accordingly, theaters all over the world may receive them on the Internet, convert them into original contents data using the specific execution program, and show them on the screen).

It would be obvious to one of ordinary skill in the art at the time of the inventions to combine the teachings of Nagano with the teaching of Ji and explicitly distribute video content, to the end users, where video content includes advertisements related to the user viewing history so that advertising could be much more effective.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Kanter, U.S. Publication No. 20020019774
- Babu, U.S. Publication No. 20040003396
- Shintani et al., U.S. Publication N. 20020124249
- Wolfe, U.S. Patent No. 7043526
- Landsman et al., U.S. Patent No. 6466967
- Wolfe, U.S. patent No. 6336131
- Srinivasan et al., U.S. Patent No. 6411992

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kris Mittal whose telephone number is (571)270-5492. The examiner can normally be reached on Monday-Thursday 7.30 AM-5.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on 571-272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4115

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KM

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 4115